

1 DAVID P. ENZMINGER (SBN: 137065)  
*denzminger@winston.com*

2 JAMES C. LIN (SBN: 271673)  
*jalin@winston.com*

3 WINSTON & STRAWN LLP  
275 Middlefield Rd., Suite 205  
4 Menlo Park, CA 94025  
Telephone: (650) 858-6500  
5 Facsimile: (650) 858-6550

6 KRISHNAN PADMANABHAN (SBN: 254220)  
*kpadmanabhan@winston.com*

7 WINSTON & STRAWN LLP  
200 Park Avenue  
8 New York, NY 10166  
Telephone: (212) 294-6700  
9 Facsimile: (212) 294-4700

10 Attorneys for Plaintiff  
CISCO SYSTEMS, Inc.

11  
12 UNITED STATES DISTRICT COURT  
13 NORTHERN DISTRICT OF CALIFORNIA

14 CISCO SYSTEMS, INC.,

15 Plaintiff,

16 vs.

17 CAPELLA PHOTONICS, INC.

18 Defendant.

**Case No. 5:20-cv-01858-LHK**

**PLAINTIFF CISCO SYSTEMS, INC.’S  
NOTICE AND ADMINISTRATIVE MOTION  
TO CONSIDER WHETHER CAPELLA  
PHOTONICS, INC. V. CISCO SYSTEMS, INC.  
(NDCA-3-14-CV-03348) SHOULD BE  
RELATED TO THE CURRENT CASE**

19  
20 TO ALL PARTIES AND THEIR COUNSEL OF RECORD:

21 Plaintiff Cisco Systems, Inc. (“Cisco”) files this motion to comply with its obligation under  
22 Civil L.R. 3-12, which states: “Whenever a party knows or learns that an action, filed in or removed  
23 to this district is... related to an action which is or was pending in this District... the party must  
24 promptly file in the earliest-filed case an Administrative Motion to Consider Whether Cases Should  
25 Be Related.” Civil L.R. 3-12(b). The above captioned case is related to *Cappella Photonic, Inc. v.*  
26 *Cisco Systems, Inc.*, Case No. 3:14-cv-03348-EMC, which was previously litigated in this District  
27 before the Honorable Edward M. Chen.

28 On February 12, 2014, Defendant Capella Photonics, Inc. (“Capella”) asserted infringement

by Cisco of U.S. Patent Nos. RE42,368 (“368 Patent”) and RE 42,678 (“678 Patent”) in the Southern District of Florida, Case No. 14-20529-CIV-SEITZ. That case was transferred to the Northern District of California, *Capella Photonic, Inc. v. Cisco Systems, Inc.*, 3:14-cv-03348-EMC (“Prior Litigation”). *See* Dkt. 1 (Complaint) ¶ 8. During the Prior Litigation in 2014, Cisco filed petitions with the Patent Trial and Appeal Board seeking institution of *inter partes* review of the challenged claims of both the ’368 Patent and ’678 Patent (IPR2014-01166 and IPR2014-01276). The Patent Trial and Appeal Board issued final written decisions cancelling claims 1-6, 9-13, and 15-22 of the ’368 Patent and invalidating claims 1-4, 9, 10, 13, 17, 19-23, 27, 29, 44-46, 53, and 61-65 of the ’678 Patent. Both decisions were further affirmed by the Federal Circuit. *Id at* ¶¶ 12-13, 23-24, Exhs. C, D, H, L and N. Thereafter, Capella placed both patent ’368 Patent and ’678 Patent into reissue proceedings, and those reissue proceedings resulted in U.S. Patent Nos. RE47,905 (“’905 patent”) and RE47,906 (“’906 patent”) respectively. *Id at* ¶¶ 14-15, 25-26, Exhs. E, F, I, J, M and O. On March 16, 2020, Cisco filed a Complaint for Declaratory Relief for non-infringement of the ’905 Patent and ’906 Patent (“Current Litigation”).

The Current Litigation is plainly related to the Prior Litigation. “An action is related to another when: (1) The actions concern substantially the same parties, property, transaction or event; and (2) It appears likely that there will be an unduly burdensome duplication of labor and expense or conflicting results if the cases are conducted before different Judges.” Civil L. R. 3-12(a). The patents-in-suit in the Current Litigation share a common specification with, and have claims amended from, the patents-in-suit in the prior litigation. During the course of reissue proceedings, Capella represented that claims of both the ’905 and ’906 Patents have the same scope as claims of the ’368 and ’678 Patents that Capella accused Cisco of infringement in the Prior Litigation. *See* Dkt. 1 (Complaint) ¶¶ 4, 5, 16-21, 27-32. Given this relationship, there will be common issues of fact and law between the Current Litigation and Prior Litigation.

Accordingly, Cisco respectfully asks the Court to declare the Current Litigation a related case to the Prior Litigation pursuant to Civil L.R. 3-12.

1 Dated: March 31, 2020

WINSTON & STRAWN LLP

2 By: K. Padmanabhan  
3 David P. Enzminger  
4 Krishnan Padmanabhan  
5 James Lin

6 Attorneys for Plaintiff  
7 CISCO SYSTEMS, Inc.  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28